

REMARKS

Reconsideration of the subject application is respectfully requested in view of the preceding amendments and for the following reasons.

In the outstanding Official Action, the Patent Office rejects claims 16-26, 31-33, 36, 41-42 and 46 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter “which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (Action, page 2). In particular, the Patent Office alleges that the “specification does not appear to provide a written description of a consistency of the compositions.” (Action, page 2). Applicant respectfully traverses this rejection and asserts that the present claims satisfy the written description requirement for at least the following reasons.

The Patent Office has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in Applicant’s disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (C.C.P.A. 1976). In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000). Nor does the original disclosure have to contain a working example or embodiment illustrating the limitation at issue. Moreover, a structure, process or property not explicitly described satisfies the written description requirement if it is inherent in what is described. See *In re Dossel*, 115 F.3d 942 (Fed. Cir. 1997). Determination of

whether the written description requirement is satisfied requires reading the disclosure in light of the knowledge possessed by those skilled in the art. That knowledge can be established by affidavits and by reference to patents and publications available to the public prior to the filing date of the application. See, e.g., *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996); *In re Lange*, 644 F.2d 856 (C.C.P.A. 1981).

In the interest of advancing the prosecution of the subject application, Applicant has clarified the rejected independent claims to recite a “means for applying the first and second compositions to massage the first and the second compositions into the skin ... wherein the first composition and the second composition are of a flowable liquid consistency, which dries on the skin, so that the compositions are not removed from the skin ...”, as supported throughout Applicant’s specification. For example, the Examiner’s attention is respectfully directed to the specification at page 11, third full paragraph, and the Examples at pages 12-15, which set forth composition constituents. As disclosed at page 11,

[t]he formulation of step 1 is applied all over the area of the skin to be treated, preferably in a circular motion, and allowed to dry for approximately 3 minutes. The formulation of step 2 is then applied in the same manner and allowed to dry completely. After step 2 is dried, moisturizer, sunscreen and/or makeup may be applied as usual. Neither formulation should be rinsed off of the skin.

One skilled in the art reading Applicant’s disclosure would understand that the first and second compositions are to remain on the skin to function and thus are not removed. The fact that Applicant discloses application of the second composition after application of the first composition to neutralize the first composition clearly indicates that the first composition is not removed. Applicant further states that “neither formulation should be rinsed off of the skin.”

One skilled in the art would understand that rinsing should not be employed so that the compositions are thus not removed from the skin. Moreover, U.S. Patent 5,720,949 to Davis, which issued February 24, 1998, distinguishes its mask, which in contrast to the present invention is scraped off with a spatula or similar means, from products “generally massaged into the skin of the consumer” and “[a]ccordingly they are not removed.” Col. 1, lines 25-32. Accordingly, withdrawal of the above rejection is believed to be warranted.

The Patent Office also rejected claims 16-26, 31-33, 36, 41-42 and 46 under the second paragraph of 35 U.S.C. § 112 because the Examiner contends that it is allegedly “unclear what consistency the compositions need to be ...” (Action, page 3). In view of the foregoing, this rejection is believed to be met and should be withdrawn.

Claims 10-22, 24-26, 31-33, 36-37, 39-40 and 43-46 were then rejected under 35 U.S.C. § 102(b) as being anticipated by and/or under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 5,720,949 to Davis (“Davis”). Similarly, dependent claim 23 was rejected under 35 U.S.C. § 103(a) as being obvious over Davis in view of U.S. Patent No. 4,797,273 to Linn et al. (“Linn”) and Database REGISTRY on STN for polysorbate-20 (“Registry”). Lastly, kit claims 38, 41 and 42 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the combined teachings of Davis and U.S. Patent No. 5,242,433 to Smith et al. (“Smith”). Applicant respectfully traverses the foregoing rejections and asserts that the primary reference, Davis, whether viewed alone or in combination with any/all of the afore-cited secondary references, neither discloses nor suggests Applicant’s presently claimed invention for at least the following

reasons.

In order for a claim to be rejected on the basis of anticipation under 35 U.S.C. § 102, a single prior art reference must disclose each and every element of the claim. Davis, the reference relied upon by the Patent Office, does not disclose each element of independent claims 10, 16, 37, 40-41 and 44-46. Accordingly, Davis does not anticipate these claims.

Specifically, Applicant's independent method claims, claims 10, 37, 40, 44-45, recite, for example, that the particularly claimed first and the second dermatological compositions are of a flowable, liquid consistency. Applicant's claimed method advantageously includes the sequential steps of applying the first composition and allowing it to dry on the skin, neutralizing the first composition by applying the second dermatological composition and then allowing the second composition to dry. Advantageously, the first and second compositions are both applied by massaging into the skin and are not thereafter removed from the skin. Similarly, Applicant's independent kit claims, claims 16, 41 and 46 recite, for example, that the first and second compositions are of a flowable liquid consistency, which dries on the skin so that the compositions are not removed from the skin.

In contrast, Davis describes a cosmetic mask. In describing this cosmetic mask, Davis teaches that a suitable first composition comprises a thickening agent effective to provide a viscosity of from about 50,000 to about 1 million cps at 25°C and a suitable second composition is a gel comprising, in part, a thickening agent effective to provide a viscosity of from about

25,000 to about 500,000 cps at 25°C (Col. 3, lines 30-66 of Davis). The first and second compositions are combined to give the cosmetic mask product.

These paste compositions of Davis must be applied to the skin using a spatula or other similar means. (Col. 2, line 42) and do not flow appreciably when applied to the skin (Col. 3, line 12; Col. 3, line 41). This is consistent with the high viscosities of the Davis compositions described above and the disclosures throughout the Davis reference that the Davis compositions “do not flow appreciably.” The mask of David results in a thick layer on the skin which subsequently is removed from the skin by means of a cloth or scraper (Col. 1, lines 35-49 of Davis). Davis also specifies that a nonliquid organic material is incorporated to ensure that the first composition has sufficient body, and thus will not drip or run when applied to the skin (Col. 4, lines 37-40). This paste “is applied to the face of a consumer uniformly and without massaging into the skin” (Col. 12, lines 65-67). At Col. 1, lines 20-49, Davis also distinguishes its cosmetic mask from products that are “generally massaged into the skin of the consumer” and [a]ccordingly, they are not removed.” One of ordinary skill in the art would understand from Davis that it would not be desirable or even capable to apply makeup over this cosmetic “mask.”

Accordingly, Applicant respectfully asserts the subject matter of independent claims 10, 16, 37, 40-41 and 44-46 is not anticipated by Davis. Additionally, since the remaining rejected claims are dependent upon at least one of these independent claims, the subject matter of those claims also is not anticipated for at least the same reasons.

Applicant further respectfully asserts that Davis, whether viewed alone or in combination with any/all of the cited secondary references neither discloses nor suggests Applicant's presently claimed invention.

Davis has been described above, and Applicant respectfully asserts that one skilled the art seeking to develop that which Applicant presently claims, would not even be motivated to look to Davis for guidance. For example, Applicants respectfully point out that the Davis paste or mask is "scraped off" of the skin, and the disclosed viscosities of Davis warrant removal from the skin. Clearly, Applicant's presently claimed compositions are not scraped off the skin and need not be to function and achieve the skin benefits of the present invention.

Applicants further assert that the addition of Linn, Smith or the Registry reference, alone or in combination, does not cure the shortcomings of Davis. For example, Linn and the Registry reference were cited as merely relating to polysorbate and Smith as disclosing pads.

Applicants respectfully assert that the Examiner has not pointed to any teaching or suggestion that would motivate one skilled in the art to arrive at the presently claimed invention. It is well established that "there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988). There must be some prior art teaching that would have provided that necessary incentive or motivation for modifying the primary reference in the manner suggested by the Examiner. As stated by the Federal Circuit in *In re Fritch*:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggest the desirability of the modification.

23 U.S.P.Q. 2d. Thus, in order to reject a claim for obviousness under 35 U.S.C. § 103, the prior art must teach or suggest each and every element of the claim and must also suggest combining the elements in the manner contemplated by the claim. See also , *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir.), *cert. denied*, 111 S.Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990). However, none of the references the Examiner cites, alone or in combination, teaches or suggests each of the elements recited in Applicant's independent claims 10, 16, 37, 40-41 and 44-45 or in any of the claims depending upon these claims for the foregoing reasons. Accordingly, reconsideration and withdrawal of these rejections are believed to be warranted.

In furtherance to the above, Applicant respectfully points out that the Examiner cites U.S. Patent 6,171,347 to Kunz (Kunz), which is an English equivalent to WO 98/22078, at page 7 of the outstanding Action. However, it is not clear from the Action if the Examiner is applying this reference in any rejection.

Applicants respectfully assert that Kunz, whether viewed alone or in combination with any/all of the previously cited references neither discloses nor suggests Applicant's presently claimed invention. For example, Applicant's claims include a kit for the treatment of the skin of a consumer comprising a first *dermatological* composition and a second *dermatological* composition. The first dermatological composition comprises an effective amount of an acid

suitable as a skin renewing acid and has a pH between about 2.5 and about 4. The second dermatological composition, which comprises an alkaline agent, is applied to the skin following the first composition, thus neutralizing the first composition.

In contrast to the present invention, Kunz teaches a method and composition for *reductively removing color from dyed hair*. The kit described therein is a multi-component kit for coloring hair and then later removing the color. *Kunz does not teach nor suggest Applicant's first and second compositions, which are dermatological*. The first composition of Kunz is an oxidative hair dye applied to the hair for the purpose of adjusting hair color. This first composition may be acidic or basic. After the oxidative dye composition has been applied to the hair, it is rinsed off and the hair dried. The consumer now has a hair color which has been adjusted by the first composition and can be worn that way until the consumer decides to remove the color.

Kunz then teaches that after a period of time, the consumer may remove the hair color using a stripping composition. *The stripping composition has an acidic pH of 1.8-6 -- the second composition of Kunz is acidic. The stripping composition is not applied directly after the oxidative dying composition in order to neutralize it, but rather is applied after the hair has been rinsed and a period of time has passed.* One would not apply the oxidative dying and reductive stripping compositions of Kunz to the skin to achieve the benefits of the present invention.

Applicant further respectfully points out that the “dermatological” limitation also appears

in the body of Applicant's claims and describes the first and second compositions. One would not be motivated to apply the oxidative hair dye of Kunz to the skin or apply an acidic stripping composition of Kunz to the skin. This simply is not the case. Kunz is directed to hair color compositions and removal of color from hair, and is not at all concerned with dermatological (skin) compositions.

Additionally, it is respectfully noted that Applicant's claimed kit is for treating the skin of a consumer by enhancement of skin appearance, whereby said enhancement is selected from the group consisting of reduction of lines and wrinkles, reduction of pore size, exfoliation of the skin, elimination of acne, toning of the skin, enhancement of skin radiancy, and softer, smoother skin with a more uniform appearance, as supported in Applicant's specification at page 12. Applicant's first and second compositions, which are dermatological, cause this enhancement.

Kunz does not teach or suggest Applicant's compositions or kit, as claimed herein, and one skilled in the art seeking to develop Applicant's invention would not even be motivated to look to this reference for guidance.

In view of the amendments and remarks set forth herein, the application is believed to be in condition for immediate allowance. Accordingly, a Notice of Allowance is respectfully requested.

The Examiner is encouraged to telephone the undersigned at 212-908-6320 if the

Examiner has any questions.

The Office is hereby authorized to charge any required fees or credit any overpayments to
Deposit Account No. 11-0600.

Respectfully submitted,
KENYON & KENYON

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claims 10, 16, 37, 40-41 and 44-46, and add new claims 47-53 as follows:

10. (Amended) A method for the treatment of the skin of a consumer comprising the sequential steps of:

- a) applying to the skin a first dermatological composition, which is of a flowable liquid consistency, comprising an effective amount of an acid suitable as a skin renewing acid in a cosmetically acceptable vehicle, wherein the pH of the first dermatological composition is between about 2.5 and about 4, and allowing the first dermatological composition to dry on the skin; and
- b) neutralizing said first composition by applying to the skin a second dermatological composition, which is of a flowable liquid consistency, comprising an alkaline agent suitable for use in a skin care composition, and from about 0.1 to about 10% of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the pH of the second dermatological composition is greater than about 7 to about 12, and allowing the second dermatological composition to dry; wherein the first composition and the second composition are both applied by massaging into the skin and are not thereafter removed from the skin [are not rinsed off of the skin], wherein makeup or other cosmetic is capable of being applied thereafter to the skin.

16. (Amended) A kit for treating the skin of a consumer by enhancement of skin appearance, comprising:

a first dermatological composition comprising an effective amount of an acid suitable as a skin renewing acid in a cosmetically acceptable vehicle, wherein the pH of the first dermatological composition is between about 2.5 and about 4;

a second dermatological composition, which neutralizes said first dermatological composition, comprising an alkaline agent suitable for use in a skin care composition and about 0.1 to about 10 percent of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the pH of the second dermatological composition is greater than about 7 to about 12; and

a means for applying the first and second compositions to massage the first and the second compositions into the skin, the compositions being adapted for sequential application to the skin of the consumer, wherein the first composition and the second composition are of a flowable liquid consistency, which dries on the skin so that the compositions are not removed from the skin [rinsed off of the skin], and that makeup or other cosmetic is capable of being applied thereafter to the skin;

whereby said enhancement is selected from the group consisting of reduction of lines and wrinkles, reduction of pore size, exfoliation of the skin, elimination of acne, toning of the skin, enhancement of skin radiancy, and softer, smoother skin with a more uniform appearance; the first and second [dermatological] compositions, which are dermatological, causing said enhancement.

37. (Amended) A method for treatment of the skin of a consumer comprising the sequential steps of:

a) applying to the skin a first dermatological composition, which is of a flowable liquid consistency, comprising an effective amount of an acid selected from the group consisting of alpha hydroxy acid, beta hydroxy acid and trichloroacetic acid in a cosmetically acceptable vehicle, wherein the pH of the first dermatological composition is between about 2.5 and about 4, and allowing the first composition to dry on the skin; and

b) neutralizing said first composition by applying to the skin a second dermatological composition, which is of a flowable liquid consistency, comprising an alkaline agent selected from the group consisting of sodium bicarbonate and sodium hydroxide, and from about 0.1 to about 10% of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the pH of the second dermatological composition is greater than about 7 to about 12, and allowing the second composition to dry, wherein the first composition and the second composition are both applied by massaging into the skin and are not thereafter removed from the skin [are not rinsed off of the skin], wherein makeup or other cosmetic is capable of being applied thereafter to the skin.

40. (Amended) A method for treatment of the skin of a consumer comprising the sequential steps of:

a) applying to the skin a first dermatological composition, which is of a flowable liquid consistency, consisting essentially of an effective amount of an acid suitable as a skin renewing acid in a cosmetically acceptable vehicle, wherein the pH of the first dermatological composition

is between about 2.5 and about 4, and allowing the first composition to dry on the skin; and

b) neutralizing said first composition by applying to the skin a second dermatological composition, which is of a flowable liquid consistency, consisting essentially of an alkaline agent suitable for use in a skin care composition, and from about 0.1 to about 10% of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the pH of the second dermatological composition is greater than about 7 to about 12, and allowing the second composition to dry; wherein the first composition and the second composition are both applied by massaging into the skin and are not thereafter removed from the skin [not rinsed off of the skin], wherein makeup or other cosmetic is capable of being applied thereafter to the skin.

41. (Amended) A kit for treating the skin of a consumer by enhancement of skin appearance, comprising:

a first dermatological composition comprising an effective amount of an acid suitable as a skin renewing acid in a cosmetically acceptable vehicle, wherein the pH of the first dermatological composition is between about 2.5 and about 4;

a second dermatological composition, which neutralizes said first dermatological composition, comprising an alkaline agent suitable for use in a skin care composition and about 0.1 to about 10 percent of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the pH of the second dermatological composition is greater than about 7 to about 12; and

single-use pads for [applying] massaging the first and second compositions into the skin, the compositions being adapted for sequential application to the skin of the consumer, wherein

the first composition and the second composition are of a flowable liquid consistency, which dries on the skin so that the compositions are not removed from the skin [rinsed off of the skin] after application to the skin by use of a single-use pad, and that makeup or other cosmetic is capable of being applied thereafter to the skin;

whereby said enhancement is selected from the group consisting of reduction of lines and wrinkles, reduction of pore size, exfoliation of the skin, elimination of acne, toning of the skin, enhancement of skin radiancy, and softer, smoother skin with a more uniform appearance; the first and second [dermatological] compositions, which are dermatological, causing said enhancement.

44. (Amended) A method for treatment of the skin of a consumer consisting essentially of the sequential steps of:

a) applying to the skin a first dermatological composition, which is of a flowable liquid consistency, comprising an effective amount of an acid suitable as a skin renewing acid in a cosmetically acceptable vehicle, wherein the pH of the first dermatological composition is between about 2.5 and about 4, and allowing the first dermatological composition to dry on the skin; and

b) neutralizing said first composition by applying to the skin a second dermatological composition, which is of a flowable liquid consistency, comprising an alkaline agent suitable for use in a skin care composition, and from about 0.1 to about 10% of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the pH of the second dermatological composition is greater than about 7 to about 12, and allowing the second

dermatological composition to dry, wherein the first composition and the second composition are both applied with a pad by massaging into the skin and are not thereafter removed from the skin [not rinsed off of the skin], wherein the first composition and the second composition are each applied with a pad, and makeup or other cosmetic is capable of being applied thereafter to the skin.

45. (Amended) A method for the treatment of the skin of a consumer comprising the sequential steps of:

a) applying to the skin a first dermatological composition, which is of a flowable consistency, comprising an effective amount of a skin renewing acid in a cosmetically acceptable vehicle, wherein the skin renewing acid is selected from the group consisting of hydroxy carboxylic acids, keto acids, hydroxybenzoic acids, and combinations thereof, and the pH of the first dermatological composition is between about 2.5 and about 4, and allowing the first dermatological composition to dry on the skin; and

b) neutralizing said first composition by applying to the skin a second dermatological composition, which is of a flowable consistency, comprising an alkaline agent suitable for use in a skin care composition and from about 0.1 to about 10% of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the alkaline agent is sodium bicarbonate or sodium hydroxide, and the pH of the second composition is greater than about 7 to about 12, and allowing the second dermatological composition to dry, wherein the first composition and the second composition are both applied by massaging into the skin and are not thereafter removed from the skin [not rinsed off of the skin], wherein makeup or other cosmetic is capable of being

applied thereafter to the skin.

46. (Amended) A kit for treating the skin of a consumer by enhancement of skin appearance, comprising:

a first dermatological composition comprising an effective amount of a skin renewing acid in a cosmetically acceptable vehicle, wherein the skin renewing acid is selected from the group consisting of hydroxy carboxylic acids, keto acids, hydroxybenzoic acids, and combinations thereof, and the pH of the first dermatological composition is between about 2.5 and about 4; and

a second dermatological composition, which neutralizes said first dermatological composition, comprising an alkaline agent suitable for use in a skin care composition and from about 0.1 to about 10% of at least one surfactant/emulsifying agent in a cosmetically acceptable vehicle, wherein the alkaline agent is sodium bicarbonate or sodium hydroxide, and the pH of the second dermatological composition is greater than about 7 to about 12; and

a means for applying the first and second compositions to massage the first and the second compositions into the skin, the compositions being adapted for sequential application to the skin of the consumer, wherein the first composition and the second composition are of a flowable liquid consistency, which dries on the skin so that the compositions are not removed from the skin [rinsed off of the skin], and that makeup or other cosmetic is capable of being applied thereafter to the skin;

whereby said enhancement is selected from the group consisting of reduction of lines and wrinkles, reduction of pore size, exfoliation of the skin, elimination of acne, toning of the skin,

enhancement of skin radiancy, and softer, smoother skin with a more uniform appearance; the first and second [dermatological] compositions, which are dermatological, causing said enhancement.

47. (New) The method of claim 10 wherein the first dermatological composition and the second dermatological composition are applied to a face.

48. (New) The method of claim 37 wherein the first dermatological composition and the second dermatological composition are applied to a face.

49. (New) The method of claim 40 wherein the first dermatological composition and the second dermatological composition are applied to a face.

50. (New) The method of claim 44 wherein the first dermatological composition and the second dermatological composition are applied to a face.

51. (New) The kit of claim 16 wherein the first dermatological composition and the second dermatological composition are facial compositions.

52. (New) The kit of claim 41 wherein the first dermatological composition and the second dermatological composition are facial compositions.

53. (New) The kit of claim 46 wherein the first dermatological composition and the second dermatological composition are facial compositions.